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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,793	01/23/2001	Tim Carruthers	109.635.128	2247
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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A./OPTV P.O. BOX 2938 MINNEAPOLIS, MN 55402-0938				
			EXAMINER CHAMPAGNE, DONALD	
			ART UNIT 3622	PAPER NUMBER

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/767,793

**Applicant(s)**

CARRUTHERS ET AL.

**Examiner**

Donald L. Champagne

**Art Unit**

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-13 and 15-68 is/are rejected.  
7) ☒ Claim(s) 14 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 26 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6 Sept. 2005.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Information Disclosure Statements*

1. All five copies of Form PTO-1449 previously submitted by applicant, and re-submitted on 6 September 2005 in response to the examiner's request, have been fully certified and made of record.

### *Response to Arguments*

2. Applicant's arguments filed on 6 September 2005 have been fully considered but they not fully persuasive. The arguments are discussed at para. 4 and 11-14 below.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2, 25, 43 and 60-68 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the remainder of the claims, does not reasonably provide enablement for the subject claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

For claims 2, 25, 43, 65 and 66, there is no enablement for "known behavior of individual users", i.e., there is no disclosure as to how said behavior is known. Applicant argues (p. 13) that support for these claims is in para. [0042] and [0029] of the published application. The examiner does not agree. However, the subject claims would be supported, and the rejection of these claims withdrawn, if amended as follows: "~~determined~~ estimated from ~~known~~ observed behavior".

For claims 60-68, there is no enablement for determining an expected number of deliveries based on the expected position. Applicant argues (pp. 13-14) that support for these claims is in para. [0055], [0059] and [0048] of the published spec. The examiner does not agree. The cited para. deal only with determining expected position, with is not at issue. Para.

[0066]-[0068] illustrate how to estimate an upper bound (constraint value) on the number of deliveries, but an upper bound is not an expected value. An expected number of deliveries, literally "DeliveriesExpected", appears to be mentioned only in para. [0072] of the published application. Para. [0070] refers to "additional mathematics" used to arrive at the "delivery ratio" incorporating "DeliveriesExpected". That is not sufficient to satisfy the enablement requirement of 35 U.S.C. 112, first paragraph.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-13 and 15-59 are rejected under 35 U.S.C. 103(a) as being obvious over Dimitriadis et al. (US005664949A) in view of March et al. (US005848397A).
7. Dimitriadis et al. teaches (independent claims 1, 24, 38, 39, 42 and 56) a method and system for scheduling the delivery of multiple items/advertisements, the method comprising: generating an ordered master list (*a sequence of index values*, col. 5 line 11) of the advertisement items to be selectively delivered to the user, said ordered list being prioritized to meet delivery requirements associated with said advertisement items (the *conditions* in *conditions list 400b*, col. 5 line 66 to col. 6 line 5; see also col. 2 lines 3-11, col. 3 lines 29-30, col. 4 lines 24-26 and 40-41 and col. 5 lines 1-12); dynamically generating an individual list of items (the *queue of associated records 400 for presentation*, col. 9 lines 3-4 in col. 8 line 59 to col. 9 line 5) to be delivered to each user on user login (when *information device 40*, col. 4 lines 1-8, is on), said individual list specifying items of content that said user is eligible to receive based on user profile data and in an order in accordance with said ordered master list, and delivering to each logged on user items of advertising content specified in the user's individual list.
8. Dimitriadis et al. does not teach determining expected values relating to each user being online during a given time period and generating the ordered list based on said expected values. March et al. teaches determining expected values relating to each user *viewing*

*advertising* during a given time period (col. 15 lines 60-61) and generating the ordered list based on said expected values, where the ordered list is defined by the *weighting constants*  $c_1, c_2, \dots$  of the *weighted scheduling criteria* (col. 4 lines 7-15, col. 10 lines 29-38 and col. 13 lines 8-18). Because March et al. teaches a simple means of weighted multiple criteria, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to combine the teachings of March et al. with those of Dimitriadis et al. Also, by the following interpretation of the term "being online", said user *viewing advertising* reads on said user "being online". Dimitriadis et al. also does not teach (claim 39) a central computer. March et al. teaches server system 104 (col. 5 line 31), which reads on a central computer.

9. Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".
10. The instant application contains no such clear definition for the phrase "being online". Hence, the examiner is required to give the phrase its broadest reasonable interpretation, which the examiner judges to "served by or available through a system" (Merriam-Webster's Collegiate Dictionary). The user's action in March et al. reads on that.
11. Applicant argues (pp. 14-15) that "it is not clear" that the examiner has made a *prima facie* case of obviousness. The examiner, of course, disagrees. It is up to applicant to refute the examiner's alleged *prima facie* case, and, except for one instance (para. 12 immediately below), applicant has not tried to do that.
12. Applicant argues (p. 15, first full para.) that the weighing constants in Marsh et al. are directed towards the advertisements, not the user. The weights describe, *for each selected user, advertisement consumption and the current advertisement load of the user* (col. 15 lines 56-65), which is clearly directed towards the user. Ads cannot consume themselves; ad consumption is a property of the user.

13. Applicant disagrees (p. 15, bottom para.) with the logic of para. 8-10 above. Applicant is entitled to disagree, but that does not constitute contrary evidence or convincing argument. Applicant argues that March et al. uses a narrower definition of "being online" (col. 6 line 66 to col. 7 line 1). If applicant wanted a narrower definition, applicant should have clearly defined "being online", as indicated in para. 9 above. Under the circumstances, the examiner is required to give the term its *broadest* reasonable interpretation. Applicant may disagree that the examiner's interpretation is reasonable, but citing three lines in March et al. hardly demonstrates the point conclusively. That is especially so because March et al. also uses the term "online" with the broader interpretation chosen by the examiner (col. 1 line 20).
14. Applicant argues (p. 16, second para.) that it is not clear that Marsh et al. recites the "central computer" of claim 39. The examiner believes that it is clear upon reading Marsh et al. that *server system 104* (col. 5 line 31) reads on a central computer. That point has now been made explicit at the end of para. 8 above.
15. Dimitriadis et al. also teaches at the citations given above claims 5, 6, 8-11, 15, 21, 28, 30, 46, 48, 51 and 57.
16. Marsh et al. also teaches claims 2, 25 and 43 (col. 15 lines 57-60); claims 3, 4, 26, 27, 44 and 45, where the probability of each user being online is unity (para. 9-10 above); claims 12, 13, 20, 31, 32, 37, 49, 50, 55, 58 and 59 (col. 3 line 66 to col. 4 line 2); claims 16, 17, 33, 34, 52 and 53 (col. 7 lines 66-67, where *showcase* reads on pop-up); claims 18, 35 and 54 (col. 4 lines 29-39); claim 22, where the *partial ordering* (col. 4 lines 7-17 and col. 10 line 53 to col. 12 line 2); claim 23, where the variable  $c_4$ : *percent remaining exposures* (col. 9 line 47 and col. 10 line 38) is 1 minus the ratio of deliveries to desired deliveries; and claims 36, 40 and 41 (col. 2 lines 26-28).
17. Neither reference teaches (claims 7, 29 and 47) that said ordered (master) list is generated daily. Because Dimitriadis et al. teaches that it is desirable to download the list at night (col. 6 lines 28-29), Marsh et al. suggests frequent updating of the ad stock (col. 2 lines 52-54) and the user device is likely to be used daily, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Dimitriadis et al. and Marsh et al. that said ordered (master) list is generated daily.

***Allowable Subject Matter***

18. Claim 14 is objected to as being dependent upon a rejected base claim, but would likely be allowable (see para. 20 below) if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
19. Claims 60-68 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first paragraph.
20. The examiner does not search individual dependent claims in the non-patent literature until applicant has put said claim(s) into condition for allowance. Allowance is further dependent on successful vetting by a "second pair of eyes".

***Conclusion***

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
22. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
24. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
26. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
27. Applicant may have after final arguments considered and amendments entered by filing an RCE.
28. **ABANDONMENT** – If examiner cannot by telephone verify applicant’s intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office’s web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DONALD L. CHAMPAGNE  
PRIMARY EXAMINER

Donald L. Champagne  
Primary Examiner  
Art Unit 3622

26 November 2005

